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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,556	01/23/2002	Hiroyuki Terada	1614.1209	4977

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EXAMINER

CHANDLER, SARA M

ART UNIT PAPER NUMBER

3693

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/052,556	Applicant(s) TERADA, HIROYUKI	
	Examiner Sara Chandler	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 8 and 9 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The following inventions are related as subcombinations disclosed as usable together in a single combination. I. Claims 1-7 drawn to a method/apparatus/computer-readable recording medium for intermediating trading between a building materials manufacturer and a fabrication factory. II. Claims 8 and 9 drawn to an apparatus. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as locating a fabrication factory capable of satisfying requirements of said order received information from a storing part storing fabrication ability information of said fabrication factory.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8 and 9 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Independent claims 1,4 and 5 recite the limitation "capable of". "capable of" is not a limitation in a patentable sense. It is not required that what follows the phrase must be done, only that is possible. Dependent claims 2,3,6 and 7 are rejected under the same rationale.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Reinsma, US Pub. No. 2002/0116239.

Re Claim 1: Reinsma discloses a method for intermediating trading between a building materials manufacturer and a fabrication factory, said method comprising the steps of:

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(a) receiving order received information from a construction company (Reinsma, [0007]

“a system is provided for selecting a set of items that meet a given criteria.” [0011]);

(b) locating a fabrication factory capable of satisfying requirements of said order

received information from a storing part storing fabrication ability information of said

fabrication factory (Reinsma, contractor= fabrication factory; Figs. 1,2,3,4, 4A, 6; [0071]

“A contractor module 50 is employed to organize contractor schedules and to provide a

list of available contractors and their installations costs for the items selected in the

package.”[0075] “An alliance contractor database 78 may be accessed when

determining an appropriate contractor and/or contractor schedule.” [0076][0078][0105]

“the system may be used to permit manufacturers, builders, consumers, contractors,

and suppliers to work together, which allows references to flow back and forth along the

supply chain.....”); and

(c) sending fabrication order information to said fabrication factory and sending building

materials order information including information of said fabrication factory that is a

destination to ship building materials to said building materials manufacturer, based on

said order received information (Reinsma, supplier= building materials manufacturer;

Figs. 1,2,3,4,4A, 6; [0071] “An alliance supplier module 52 is employed to organize

available suppliers and the cost of each product carried by the supplier.”

[0075][0076][0078][0105] “the system may be used to permit manufacturers, builders,

consumers, contractors, and suppliers to work together, which allows references to flow

back and forth along the supply chain.....”).

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Re Claim 3: Reinsma discloses a method, wherein said fabrication ability information includes open schedule information of said fabrication factory (Reinsma, [0071] "A contractor module 50 is employed to organize contractor schedules and to provide a list of available contractors and their installations costs for the items selected in the package." [0072][0096]).

Re Claim 4: Reinsma discloses an apparatus for intermediating trading between a building materials manufacturer and a fabrication factory, said apparatus comprising: a receiving part receiving order received information from a construction company (Reinsma, [0007] "a system is provided for selecting a set of items that meet a given criteria." [0011]);

a locating part retrieving a fabrication factory capable of satisfying requirements of said order received information from a storing part storing fabrication ability information of said fabrication factory (Reinsma, contractor= fabrication factory; Figs. 1,2,3,4, 4A, 6; [0071] "A contractor module 50 is employed to organize contractor schedules and to provide a list of available contractors and their installations costs for the items selected in the package." [0075] "An alliance contractor database 78 may be accessed when determining an appropriate contractor and/or contractor schedule." [0076][0078][0105] "the system may be used to permit manufacturers, builders, consumers, contractors, and suppliers to work together, which allows references to flow back and forth along the supply chain....."); and

a sending part sending fabrication order information to said fabrication factory and sending building materials order information including information of said fabrication

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factory that is a destination to ship building materials to said building materials manufacturer, based on said order received information (Reinsma, supplier= building materials manufacturer; Figs. 1,2,3,4,4A, 6; [0071] "An alliance supplier module 52 is employed to organize available suppliers and the cost of each product carried by the supplier." [0075][0076][0078][0105] "the system may be used to permit manufacturers, builders, consumers, contractors, and suppliers to work together, which allows references to flow back and forth along the supply chain.....").

Re Claim 5: Reinsma discloses computer-readable recording medium having program code recorded therein for causing a computer to intermediate trading between a building materials manufacturer and a fabrication factory, said program code comprising the code for:

(a) receiving order received information from a construction company (Reinsma, [0007]

"a system is provided for selecting a set of items that meet a given criteria." [0011]);

(b) locating a fabrication factory capable of satisfying requirements of said order

received information from a storing part storing fabrication ability information of said

fabrication factory (Reinsma, contractor= fabrication factory; Figs. 1,2,3,4, 4A, 6; [0071]

"A contractor module 50 is employed to organize contractor schedules and to provide a

list of available contractors and their installations costs for the items selected in the

package." [0075] "An alliance contractor database 78 may be accessed when

determining an appropriate contractor and/or contractor schedule." [0076][0078][0105]

"the system may be used to permit manufacturers, builders, consumers, contractors,

and suppliers to work together, which allows references to flow back and forth along the supply chain....."); and

(c) sending fabrication order information to said fabrication factory and sending building materials order information including information of said fabrication factory that is a destination to ship building materials to said building materials manufacturer, based on said order received information (Reinsma, supplier= building materials manufacturer; Figs. 1,2,3,4,4A, 6; [0071] "An alliance supplier module 52 is employed to organize available suppliers and the cost of each product carried by the supplier."

[0075][0076][0078][0105] "the system may be used to permit manufacturers, builders, consumers, contractors, and suppliers to work together, which allows references to flow back and forth along the supply chain.....").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2,6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over.

Re Claims 2,6 and 7: Reinsma discloses a method/apparatus/computer-readable recording medium, wherein said order received information includes fabrication indication information in which an indication of the fabrication information is shown by image (Reinsma, [0076][0078]). Reinsma fails to explicitly disclose wherein the information is customized. Eze discloses wherein the information is customized (Eze, abstract, Figs. 2,3, [0005] [0007] [0023] [0030] [0033] [0034] [0041]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Reinsma by adopting the teachings of Eze to provide the method/apparatus/computer-readable recording medium, wherein said order received information includes customized fabrication indication information in which an indication of the customized fabrication information is shown by an image. As suggested by Eze, one would have been motivated to avoid time delays and cater to user preferences..

Response to Arguments

Objections

Withdrawn in view of applicant's amendment.

101

Withdrawn in view of applicant's amendment.

112

Applicant's arguments have been fully considered but they are not persuasive.

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Claims 1-7 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Independent claims 1,4 and 5 recite the limitation "capable of". "capable of" is not a limitation in a patentable sense. It is not required that what follows the phrase must be done, only that is possible. Dependent claims 2,3,6 and 7 are rejected under the same rationale.

102

Applicant argues, Reinsma fails to explicitly disclose sending fabrication order information to said fabrication factory and sending building materials order information, including information of said fabrication factory that is a destination to ship building materials, to said building materials manufacturer, based on said order received information.

Applicant's argument has been fully considered but it is not persuasive. Giving the claim language it's broadest reasonable interpretation (See MPEP § 2111 [R-5]), the claim can be read as sending information to the parties involved. Specifically, "sending fabrication order information to said fabrication factory" and "sending buildings materials order information" "to said building materials manufacturer." In the Office Action (07/31/06), it was stated that the contractor disclosed in Reinsma was like the fabrication factory provided for in the claimed invention; and the supplier disclosed in Reinsma was like the building materials manufacturer provided for in the claimed

invention. Reinsma provides for necessary information to be sent to these parties.
(Please refer to the relevant citations in the rejection).

Applicant argues, Reinsma fails to explicitly disclose wherein said order received information includes customized fabrication indication information in which an indication of the customized fabrication information is shown by an image.

Applicant's argument has been considered but is moot in view of the new ground(s) of rejection.

Applicant argues, Reinsma fails to explicitly disclose an input interface to send the fabrication detail information to a fabrication factory and to send the building materials order information, including information of said fabrication factory that is a destination to ship building materials, to the building materials manufacturer.

Applicant's argument is in regard to newly submitted claims 8 and 9 which have been withdrawn from consideration as being directed to a non-elected invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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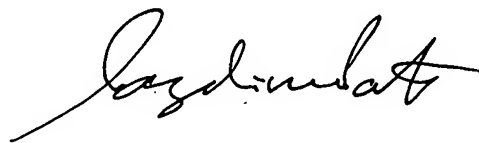
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC



JAGDISH N. PATEL
PRIMARY EXAMINER

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